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PATENT

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	:	Forsyth, et al.)	Group Art Unit 1634
)	
Appl. No.	:	09/741,669)	I hereby certify that this correspondence and all
)	marked attachments are being deposited with the
Filed	:	December 19, 2000)	United States Postal Service as first-class mail in
)	an envelope addressed to: United States Patent
For	:	GENES IDENTIFIED AS)	and Trademark Office, P.O. Box 2327,
		REQUIRED FOR)	Arlington, VA 22202, on
		PROLIFERATION OF E. COLI)	
)	<u>August 1, 2002</u>
)	(Date)
)	<u><i>Daniel Hart</i></u>
)	Daniel Hart, Reg. No. 40,637
Examiner	:	Frank Lu)	

RESPONSE TO RESTRICTION REQUIREMENT

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AUG 09 2002

United States Patent and Trademark Office
P.O. Box 2327
Arlington, VA 22202

TECH CENTER

Dear Sir:

In response to the Restriction Requirement mailed July 3, 2002, Applicants provisionally elect Group XI, the species "bacterial cells," and the nucleic acid sequence of SEQ ID NO.: 60 for further examination.

According to the Restriction Requirement, the following claim groups are subject to restriction:

- Group I comprising Claims 1-4, 9, 66, and 124
- Group II comprising Claims 5, 10, 12-14, 66, and 67
- Group III comprising Claims 6-8, 11, and 15-17
- Group IV comprising Claims 18-21
- Group V comprising Claim 22
- Group VI comprising Claims 23-25
- Group VII comprising Claims 26 and 27
- Group VIII comprising Claims 28-35, 37, and 128
- Group IX comprising Claims 36, 44, 57, 95, 98, 109, 117, 125, and 126

Group X comprising Claims 38-43 and 128
Group XI comprising Claims 45-56 and 128
Group XII comprising Claims 58-65
Group XIII comprising Claims 68-79
Group XIV comprising Claims 80-83
Group XV comprising Claims 84-94, 96, 97, and 128
Group XVI comprising Claims 99-108 and 128
Group XVII comprising Claims 110-116 and 128
Group XVIII comprising Claims 118-120
Group XIX comprising Claims 121-123
Group XX comprising Claims 127 and 128
Group XXI comprising Claims 129-131

The Applicants provisionally elect the claims of Group XI for further examination. This election is with traverse as related to the separate grouping of Group XI and Group XVI (Claims 99-108 and 128).

The Examiner also requires an election of species for elected Group XI. Applicants note that an identical species election is required for Group XVI. Applicants provisionally elect bacterial cells as the species for initial examination. Accordingly, upon allowability of the claims with respect to embodiments in which the species is bacterial cells, Applicants are entitled to seek consideration of the nonelected species as provided in 37 C.F.R. § 1.141.

In addition to the foregoing claim group and species election, the Examiner requires an election of a sequence for further prosecution. Applicants provisionally elect the nucleotide sequence of SEQ ID NO.: 60 (a nucleic acid sequence that is complementary to at least a portion of the *yidC* gene). Applicants also traverse the separation of the antisense sequence of SEQ ID NO.: 60 from the polypeptide gene product of SEQ ID NO.: 413 which is encoded by the gene of SEQ ID NO.: 220.

With respect to the sequence election,[✓] the Applicants respectfully submit that the antisense nucleic acid of SEQ ID NO.: 60, the coding nucleic acid of SEQ ID NO.: 220 and the polypeptide of SEQ ID NO.: 413 can be searched and examined together without undue burden because of their biological interrelationship. In particular, Applicants have discovered that

expression of the antisense nucleic acid of SEQ ID NO.: 60 inhibits cellular proliferation, thereby indicating that the gene of SEQ ID NO: 220 (*vidC*) and its respective encoded protein of SEQ ID NO: 413 is essential. In view of this essentiality, the antisense nucleic acid of SEQ ID NO.: 60, the gene of SEQ ID NO: 220 and the polypeptide of SEQ ID NO: 413 can be used in methods such as inhibiting the proliferation of an organism and identifying compounds which inhibit the proliferation of that organism. In view of the foregoing biological interrelationship, Applicant respectfully requests that the essential polypeptide gene product of SEQ ID NO: 413, the essential gene of SEQ ID NO.: 220 and the antisense nucleic acid of SEQ ID NO: 60 be searched and examined together.

In addition to the sequence election, Applicants respectfully traverse the restriction of elected Group XI from Group XVI. Although these claim Groups are patentably distinct, Applicants maintain that they can be examined together without serious burden on the Examiner. M.P.E.P. §803 provides that "if the search and examination of an application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions"(emphasis added). For the following reasons, examination of these claims requires a single search for references relating to the essentially of the product encoded by the *vidC* gene.

Although the claims of Groups XI and XVI, which are drawn to methods of identifying compounds that cause a reduction in cellular proliferation, are independently patentable (distinct), these claims may be examined together without serious burden because each claim flows from a single overarching concept. In particular, each claim flows from the single observation that *vidC* has been identified as an essential gene whose expression can be inhibited through the use of an antisense nucleic acid that is complementary to at least a portion of this gene, such as the elected antisense nucleic acid of SEQ ID NO.: 60. To examine claim Group XVI, the Examiner would only be required to search references which relate to the essentiality of the *vidC* gene. The same search is required for the examination of the claims of elected Group XI. Because the necessary search for both of these Groups is identical, examination of Group XVI (Claims 99-108 and 128) does not require a search beyond the search required for the claims of Group XI (Claims 45-56 and 128). Accordingly, examination of the claims of Group XVI along with the claims in elected Group XI does not impose a serious burden on the Examiner.

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Filed : December 19, 2000

Claims 1-44, 57-98, 109-127 and 129-131 are hereby withdrawn as being drawn to a non-elected invention. Applicants hereby reserve their right to prosecute these claims in further divisional or continuing applications.

If the Examiner has any questions regarding the above election or would like to discuss this response further, he is cordially invited to contact the undersigned so that any such questions may be promptly resolved.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: _____

By: _____

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Sir:

Transmitted herewith in the above-identified application:

- (X) Response to Restriction Requirement.
- (X) Return prepaid postcard.
- (X) Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Daniel Hart
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Attorney of Record